

REMARKS

Claims 1-32 are pending. By this Amendment, no claims are cancelled, amended or added.

Reissue Application

Claims 1-32 of this reissue application were rejected because it was said that the reissue declaration by the inventors fails to state an error upon which reissue can be based. Specifically, it was said that Applicants' alleged error of only means-plus-function limitations being used to recite the drive and operator elements of the device in the single independent claim of the patent does not cause the patent to be "wholly or partly inoperative or invalid" as required by 35 U.S.C. § 251. In response, Applicant has provided revised reissue declarations providing further clarification of the errors upon which the broadening reissue is based. Applicant respectfully traverses this rejection in view of the revised declarations and requests that this rejection be withdrawn.

In a situation where the original claim scope was not what the patentee had intended and a reissue patent is desired, it is sufficient for the applicant to allege generally that the original patent was rendered defective by reason of the broader or narrower claim scope. More specifically, an applicant for reissue needs to satisfy three low threshold statutory requirements in the reissue oath or declaration. *See* 35 C.F.R. § 1.175. First the applicant must state that he "believes the original patent to be wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than patentee had the right to claim in the patent." 35 CFR §1.175(a)(1) (2006). *See also Manual of Patent Examining Procedure* (MPEP) §1414. Second, the applicant must state "at least one error which is relied upon to support the reissue application, *i.e.* as the basis for the reissue." *Id.* Third, the applicant

must state that “all errors . . . arose without any deceptive intention on the part of the applicant.” 35 CFR §1.175(a)(2). *See also* MPEP §1414.

For the first requirement, it is sufficient that the applicant simply state in the reissue oath or declaration his belief of the defect as described above. MPEP §1414. Thus, in a situation where the original claim scope was not what the applicant had intended, it is sufficient that the applicant states that he “believes the original patent to be partly inoperative or invalid by reason of the patentee claiming more than patentee had a right to claim in the patent” or that he “believes the original patent to be partly inoperative or invalid by reason of the patentee claiming less than patentee had a right to claim in the patent.” *Id.* The expression “more than patentee had a right to claim” or “less than patentee had right to claim” generally refers to the scope of a claim. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 882 F.2d 1556, 1446 (Fed. Cir. 1989). The applicant need not make any further statements to satisfy this first prong. MPEP §1414.

For the second requirement, the applicant need only specify in the reissue oath or declaration at least one error that caused the original patent to be defective. MPEP §1414. “In identifying the error, it is sufficient that the reissue oath/declaration identify a single word, phrase, or expression in . . . an original claim, and how it renders the original patent wholly or partly inoperative or invalid.” *Id.* In addition, “[t]he corresponding corrective action which has been taken to correct the original patent need not be identified in the oath/declaration.” *Id.*

In the present case, one of the errors identified as a basis for reissue is that two elements of the claimed apparatus are recited using only means plus function limitations in the single independent claim of the issued patent. According to 35 U.S.C. § 112, ¶ 6, these means-plus-function limitations “shall be construed to cover the corresponding structure . . . described in the specification and equivalents thereof.” The Federal Circuit has interpreted this language to provide a relatively narrow scope of claim coverage in a series of cases beginning with *Valmont Industries Inc. v. Reinke Manufacturing Co.*, 983 F.2d 1039 (Fed. Cir. 1993). In *Valmont*, the

Federal Circuit differentiated between the purpose and application for equivalents under 35 U.S.C. § 112 ¶ 6 and for those under the doctrine of equivalents. *Id.* at 1043. It held that the equitable tripartite test of the doctrine of equivalents does not apply to equivalents under § 112 ¶ 6. *Id.* Rather, in the context of § 112 ¶ 6, the sole question “involves comparison of the structure in the accused device which performs the claimed function to the structure in the specification.” *Id.* (citing *D.M.I.*, 755 F.2d 1570, 1575 (Fed. Cir. 1985); *Durango Assocs. Inc., v. Reflange, Inc.*, 843 F.2d 1349, 1357 (Fed. Cir. 1988)). *See also* *Alpex Computer Corp. v. Nintendo Co.*, 102 F.3d 1214 (Fed. Cir. 1996) (affirming the difference between equivalents under § 112 ¶ 6 and the doctrine of equivalents). Thus, while the doctrine of equivalents “expands exclusive patent rights” for structural limitations, § 112 ¶ 6 “limits the broad language of means-plus-function limitations in combination claims to equivalents of the structures, materials, or acts in the specification.” *Valmont* at 1043. This implies that limitations written in means-plus-function language have a recognizably different, narrower claim scope than structural limitations.

The Federal Circuit construed the scope of coverage under § 112 ¶ 6 narrowly again in *Baltimore Therapeutic Equipment Co. v. Loredan Biomedical Inc.*, 30 U.S.P.Q.2d 1672 (Fed. Cir. 1994). It upheld a district court’s conclusion that a means-plus-function limitation was not the “structural equivalent” of certain structure of the accused device. The decision assumes that the “equivalents thereof” language of § 112 ¶ 6 requires the patentee, in order to prove literal infringement, to show “structural equivalence” between the disclosed means and the corresponding structure of the accused device. *Id.*

Applicants submit that the invention disclosed in the present application does not necessarily require any particular structure for the drive and operator elements of the claimed valve. Because these elements were claimed only with means-plus-function limitations in the single independent claim of the application, and because the means-plus-function limitations may be constructed as essentially limited to particular structures as set forth in the discussion

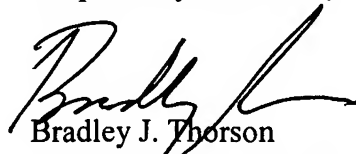
above, Applicants submit that they, as patentees, claimed less than the full scope of the invention they had a right to claim. In that Applicants have included these and all other required statements in the reissue application declarations submitted herewith, Applicants submit that they have stated a proper legal basis for reissue and accordingly request that the rejection be withdrawn.

Moreover, even though not required, Applicants have also alleged a second error forming an independent basis for reissue. Specifically, the recitation of "the housing" in dependent claim 5 has no antecedent basis. In that the lack of antecedent basis may render a claim indefinite and invalid as a result, this error is also a proper basis for reissue. Hence, Applicants have provided an additional independent and legally sufficient basis to support reissue. Consequently, Applicants respectfully request that this rejection be withdrawn.

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



Bradley J. Thorson
Registration No. 52,288

Customer No. 24113
Patterson, Thunte, Skaar & Christensen, P.A.
4800 IDS Center
80 South 8th Street
Minneapolis, Minnesota 55402-2100
Telephone: (612) 349-5756